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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,868	12/12/2001	Michael D. Hooven	HOOV 117	7290
26568	7590	06/20/2007		
COOK, ALEX, MCFARRON, MANZO, CUMMINGS & MEHLER LTD SUITE 2850 200 WEST ADAMS STREET CHICAGO, IL 60606			EXAMINER CHEN, VICTORIA W	
			ART UNIT	PAPER NUMBER
			3739	
			MAIL DATE	DELIVERY MODE
			06/20/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/015,868

**Applicant(s)**

HOOVEN, MICHAEL D.

**Examiner**

Victoria W. Chen

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 50-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 50-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/25/02 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments, filed 12/07/06, with respect to the 103(a) rejections of claims 50-56 and 58 over Paraschac (US H1745) in view of Burnside (US 6071281) and Yates (US 5688270) in view of Burnside and the 112 1<sup>st</sup> paragraph rejection of claim 57 have been fully considered and are persuasive. The 103(a) rejections of claims 50-56 and 58 and the 112 1<sup>st</sup> paragraph rejection of claim 57 have been withdrawn.

In response to applicant's argument (Arguments, pg. 7, ln. 12 to pg. 8, ln. 13) that Paraschac and Yates are for coagulation and cutting and not for forming limited lines of ablation, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 50-56 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paraschac (US H1745) in view of Buysse et al. (US 6039733) in further view of Pedros et al. (US 6248124).**

Regarding claims 50, 52 and 53, Paraschac teaches an ablation apparatus comprising first [116] and second [117] jaws [Fig. 5], the jaws being movable between open and closed positions, each jaw having a clamping surface [Fig. 5] with a width and an elongated electrically conductive member [labeled 118 and 119], the conductive members in face to face relation and connectible to a bipolar energy power source [col. 7, ll. 5-9] so as to be of opposite polarity, the conductive members each having a tissue contacting portion [118, 119] which has a width less than the width of the clamping surface of its associated jaw [Fig. 5]. However, Paraschac fails to teach at least one temperature sensor associated with at least one jaw spaced laterally from the tissue contacting portions of the conductive members. Buyse teaches a tissue sealing apparatus with conductive jaw members [Fig. 2, 16] having a temperature sensor [28] carried on at least one jaw, proximally located and spaced from the conductive members [23] in order to sense the temperature of the tissue of the patient. Pedros teaches the use of temperature sensors in order to detect when undesired treatment of neighboring tissue areas occurs [col. 6, ll. 45-47]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to use a temperature sensor carried on at least one jaw and spaced from the conductive members as taught by Buyse in the invention as taught by Paraschac in order to sense the temperature of the tissue of the patient and detect when undesired treatment of neighboring tissue areas occurs.

Regarding claim 51, it is noted that applicant's specification fails to provide any criticality and/or unexpected result associated with the claimed location of the temperature sensor. Therefore the examiner maintains that one of ordinary skill in the art would obviously recognize that any reasonable placement of the temperature sensor that enables the sensor to detect the temperature of the ambient tissue may be used to achieve the desired results.

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Furthermore, it has been held that rearranging parts of an invention involves only routine skill in the art.

Regarding claim 54, the tissue contacting portion widths taught by Paraschac [widths of elements labeled 119 and 118 in Fig. 5] can be seen to be less than or equal to about one-third of the width of the associated clamping surface [inner surfaces of 116 and 117, Fig. 5].

Regarding claim 55, Paraschac/Buysse/Pedros teach the claimed invention except for the specific length and width of the conductive members. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the length and width of the conductive members since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claim 56, Paraschac teaches the conductive member is generally centrally located relative to the clamping surface [Fig. 5].

Regarding claim 58, Paraschac teaches a portion of the clamping surface is disposed on each side of the conductive member [Fig. 5].

**Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paraschac/Buysse/Pedros in further view of Mulier (US 6096037).**

Paraschac/Buysse/Pedros teach the invention as described above, but fail to teach an interior lumen within at least one of the conductive members. Mulier teaches an electrosurgical device with jaws comprising a conductive member including an interior lumen as means of delivering conductive fluid along the length of the conductive member to facilitate energy transfer from the device to the tissue [Figs. 4 & 5]. Therefore, it would have been obvious to one

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of ordinary skill in the art at the time of invention to provide a conductive member that includes an interior lumen as means of delivering conductive fluid along the length of the conductive member to facilitate energy transfer from the device to the tissue.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6179834 B1	USPAT Buysse; Steven P. et al.	Vascular tissue sealing pressure control and method
US 5776130 A	USPAT Buysse; Steven P. et al.	Vascular tissue sealing pressure control
US 5599350 A	USPAT Schulze; Dale R. et al.	Electrosurgical clamping device with coagulation feedback
US 5674220 A	USPAT Fox; William D. et al.	Bipolar electrosurgical clamping device
US 5707369 A	USPAT Vaitekunas; Jeffrey J. et al.	Temperature feedback monitor for hemostatic surgical instrument
US 6929640 B1	USPAT Underwood; Ronald A. et al.	Methods for electrosurgical tissue contraction within the spine
US 6447505 B2	USPAT McGovern; Francis J. et al.	Balloon catheter method for intra-urethral radio-frequency urethral enlargement
US 6409722 B1	USPAT Hoey; Michael F. et al.	Apparatus and method for creating, maintaining, and controlling a virtual electrode used for the ablation of tissue

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victoria W. Chen whose telephone number is (571) 272-3356. The examiner can normally be reached on M-F 8:30-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John P. Leubecker/  
Primary Examiner, AU 3739

/VWC/  
6/11/07